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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,297	03/07/2002	Katsuya Kume	Q68478	2667

7590 04/21/2003

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,297

Applicant(s)

KUME ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/7/02 (priority).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over USPN 6,416,845 to Kume et al.

The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) and/or 103(a) might be overcome

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by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Kume teaches a printing sheet and printed sheet burned at 400 degrees C or higher, where the heat treatment temperature is from 800 degrees C or lower. While Kume does not teach a baking sheet, this description of the sheet of Kume is equivalent to a baking and burned sheet as claimed by Applicant. At col. 1, lines 60-68, the printed sheets can be easily bonded to burned sheets to exhibit excellent chemical resistance. See col. 5, lines 15-20, 60-68, and col. 7, lines 26-45. At col. 2, lines 30-68, Kume teaches a sheet comprising an ink receiving layer, PSA layer, inorganic powders, and a reinforcing substrate. Also aluminum products may be applied at col. 5, lines 60-65, information may be imparted to the sheet and can be fixed to an aluminium plate (an aluminum product of claim 15). At col. 3, lines 1 and 10-35, Kume describes the inorganic powders of metal or ceramic (claims 2 and 8). Further, Kume explains the particle size may be

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between 0.05 to 20 microns, meeting applicants claimed range of 50 microns or smaller as recited in claims 3 and 9. The silicone rubber (silicon-containing binder) and inorganic powder may be in an amount of 1 to 1000 parts by weight inorganic powder per 100 parts by weight of the silicon binder (claims 4 and 10) at col. 3, line 64 – col. 4, line 15. See also col. 6, lines 35-68. The silicone rubber and inorganic powder mixture (2) is on the surface of the printing sheet (1) in Figure 1. Kume teaches an MQ resin as in claims 7 and 15 at col. 3, lines 35-68. The fact that the burning temperature is 200 degrees C up to 1200 degrees C, as in claims 15 and 16, is immaterial. These are process conditions and are not giving patentable weight. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render Applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233.

Regarding the thermal transfer ink addition of claims 7-15, Kume teaches at col. 1, lines 55-63, thermal transfer ink can be formed by imparting ink formation by thermal transfer printing to the printed sheet. It would have been obvious to one of ordinary skill in the art to include thermal transfer ink information to one surface to provide variety as taught by Kume at col. 1, lines 58-59. See also col. 7, lines 50-55. Regarding claim 13, Figures 4 and 1 shows the PSA opposite the ink.

3. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being obvious over USPN 6,416,845 to Kume et al. in view of USPN 6,495,295 to Shioda et al.

4. Kume essentially teaches the claimed invention as applied above. However, Kume does not teach optionally including trimethylsiloxysilicic acid. In the event Applicant amends the claim to include this acid, Shioda teaches a hologram transfer printed film for forgery printing

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that comprises trimethylsiloxysilicic acid in a silicone resin for the purpose of providing a suitable releasing agent when incorporated into an image forming (hologram) layer at col. 6, lines 42-65. It would have been obvious to one of ordinary skill in the art to modify the sheet of Kume to include trimethylsiloxysilicic acid for the purpose of providing a suitable releasing agent when incorporated into an image-forming (hologram) layer as taught by at col. 6, lines 42-65.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5,328,683 to Harashima teaches trimethylsiloxysilicic acid and silicone containing resins and oils impart water repellency in inks. USPN 5,856,048 to Tahara et al. teaches printed sheets with PSA and printed hologram images. USPN 5,763,356 to Ueno et al. teaches a thermal transfer image receiving sheet with peelable polyester film and ink.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


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Tamra L. Dicus
Examiner
Art Unit 1774

April 14, 2003


N. EDWARDS
PRIMARY EXAMINER